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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,027	08/18/2006	Hiroto Kidokoro	071853	4135
38834 7590 10/13/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
LE, HOA VAN				
ART UNIT		PAPER NUMBER		
1795				
NOTIFICATION DATE		DELIVERY MODE		
10/13/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

### Office Action Summary

**Application No.**

10/590,027

**Applicant(s)**

KIDOKORO, HIROTO

**Examiner**

Hoa V. Le

**Art Unit**

1795

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2009 and 18 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 08/18/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

This is in response to Papers filed on 06/29 and 08/18/09.

I. Applicant's prior art submission filed on 08/18 has been considered to the extent of the English language ad provided.

II. It is recognized that WO 02/29497 A2 has (1) a publication date of 04/11/02, (2) equivalent teachings and/or suggestion as 7,422,833 and 2004/0013961 and (3) same Zeon Corp. assignee.

(A) A broad or narrow statement or argument to the applied WO 02/29497 by assignee and/or their counsel in this application will be consistently applied to 7,422,833.

(B) WO 02/29497 is selected because the works in the instant application and those in WO 02/29497 are done at Zeon Corp. Lab.

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oyama et al (WO 02/29497).

Oyama et al disclose, teach and suggest an electrographic toner composition comprising color resin particles having an average particle size ( $D_v$ ) of 2- 8 microns, particle diameter distribution ratio( $D_v$ )/( $D_p$ ) of less than 1.3, sphericity ratio  $r_l/r_s$  of from 1 and containing a binder resin, a colorant, a charge control agent, a parting agent. Please see the whole disclosure of the applied reference, especially in Oyama et al on at least page 4, last line to page 11, line 7, 23 to page 12, line 3, page 13, lines 5-9, page 15, lines 12-22, 28 to page 16, lines 5, 14-14, page 19, line 4-18, page 20, lines 1-5, 22 to page 22, line 5, page 25, lines 4-7, 12-22, second line from the bottom of page 31, line 20 and Examples. At the level of one skilled in the art and/or an average skill artisan at the time the invention was made would recognize that the applied toner compositions have (1) a range of circularity (sphericity), a range of share viscosity...8,000 Pa.s, a range of share viscosity...1,300 Pa.s, a ratio of range of volatilization up to 130°C/ range of volatilization above 130°C when measurements are made. Therefore, it is urged and requested applicant, assignee and/or their counsel to early, timely and candidly show or provide convincing evidence to the

contrary for an early consideration, examination and properly allowance of the claims to avoid a costly and lengthy litigation during and after an allowance of a claim. Evidence being not considered during the prosecution must be firstly considered and taken to a full and complete satisfaction before allowing or permitted any other issue to be taken. For a patentability of "tone...having the following properties...", it is allowed by law to request and require applicant, assignee and/or their counsel to provide or show convincing evidence to the contrary. An allowed claim or patent would have no value when someone reasonably show to the same or obviously about same claimed properties using all possible combinations of the broad teachings and/or suggestions from the applied reference. The language "produced by" in claims 13-15 and 19 is a product-by-process. According to the MPEP, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (MPEP 2113 [R-I], see *In re Thorpe*, 777F.2d 695,

698,227 USPQ 964,966). In this case, Oyama et al also disclose, teach and suggest the toner composition being made by a polymerization as that in the claimed. In the absence of convincing evidence to the contrary as early, timely and clearly pointed out and set forth on the record, the claims are not found to be allowable and rendered prima facie obvious by Oyama et al.

Applicant's arguments filed 06/29 have been fully considered but they are not persuasive.

- (a) The Oyama reference is a prior application of Zeon Corporation, the assignee of the present application.
- (b) It is considered that Compare Example 1 disclosed by Oyama et al. substantially corresponds to Comparative Example 1 described in the specification of the present invention, as explained below. Both Example 1 in Oyama, et al. and Comparative Example 1 of the present application were prepared by the following steps:
- i) A dispersion of a negative charge control resin in an organic solvent was kneaded by a roller under cooling. Then, when the negative charge control resin was wound on the roller, a colorant was added thereto to prepare a negative charge control resin composition.
  - ii) Styrene, butyl acrylate, the negative charge control resin composition obtained above, a molecular weight modifier (dodecyl mercaptan), and a parting agent (pentaerythritol tetrastearate) were stirred and mixed to prepare a polymerizable monomer composition.
  - iii) Separately, an aqueous dispersion of polymerizable monomer for shell was prepared by mixing methyl methacrylate and water.
  - iv) A colloidal dispersion of magnesium hydroxide was prepared by adding an aqueous solution of sodium hydroxide to an aqueous solution of magnesium chloride.
  - v) The polymerizable monomer composition obtained above was added to the colloidal dispersion of magnesium hydroxide, and the mixture was stirred until droplets were stabilized, followed by addition of a polymerization initiator (t-butyl peroxy-2-ethylhexanoate) thereto. Then, high shear stirring was performed to granulate the droplets of the polymerizable monomer composition. Subsequently, polymerization

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reaction was carried out at 90°C, and at the time when the percentage of the monomer converted into a polymer reached approximately 100%, the aqueous dispersion of polymerizable monomer for shell and an aqueous solution of a polymerization initiator were added thereto for polymerization to obtain toner particles.

The steps i) to v) above are common in Example 1 disclosed by Oyama, et al. and Comparative Example 1 described in the specification of the present application. Therefore, it is considered that Compare Example 1 disclosed by Oyama et al. substantially corresponds to Comparative Example 1 described in the specification of the present invention.

(b) Therefore, Comparative Example 1 should be compared with Example 1 of the present to find that Comparative Example 1 or Oyama et al. do not meet the claimed properties recited in the instant claims. In particular, the toner of Comparative Example 1 does not meet the claimed requirements of the shear viscosity (1\*11) and the shear viscosity (r12). See Tables 1 and 2 in the original specification.

Furthermore, the content of a volatile component, in particular, the content of a volatile component having a volatilization temperature in a range of higher than 130°C to 180°C is 40 ppm in Example 1. On the contrary, the content in Comparative Example 1 is 260 ppm, which is much larger than that in Example 1. See Tables 1 and 2 in the original specification. Example 1 of Oyama, et al. or Comparative Example 1 described in the specification of the present application is different from Example 1 of the present application in the volatile component contents.

As described above, Oyama, et al. or Comparative Example 1 described in the specification of the present application does not meet the properties recited in the instant claims. The requirements recited in the instant claims are not obvious over Oyama et al.

The arguments to the comparative examples (Oyama et al Comparative Example 1 and Comparative Example 1 in the instant application) have little to no value because a comparative example is provided to show an inferior result. If there is an argument to be given a value, it should be to an example because it shows an invention. It would like to see results of each of measurements of the property of each the applied toners as disclosed in the applied Oyama et al for determination of the patentability of the claims since arguments alone have and are given little value because they are factual evidences.

It is improper to use the applied reference Comparative Example 1 to compare to Comparative Example 1 in the instant application). It has and is given little no value because a comparative example is provided to show an inferior result as compare to an example of showing an invention.

It is an improper comparison because the chemical ingredients are not the same or an adjacent homologue. There is no measurement of each of the properties in each of the relied comparative examples. In the absence of convincing evidence of measurements, the arguments alone have no value because they are not factual evidence.

The instant claims are broader than each of the showing in Example 1 and Comparative Example 1 in the instant application. The showings have little value because none of them is reasonably commensurate in scope the broadly claimed embodiments.

The Office is interest on a tone property but is most interest in an unusual and/or unexpected result image quality. At the level of one skill in the art and/or an average skill artisan at the time the invention was made would recognize that each of the applied toners in each of the applied



Examples in Oyama et al would be able to provide a better image quality than each of the broadly claimed embodiment. Inventor, assignee and/or their counsel may and should disagree by providing convincing evidence to the contrary.

An allowed claim or patent would have no value when someone reasonably shows that at least one or more broadly claimed embodiment do not provide the same or obviously about same image quality as compared to one of Oyama et al examples.

IV. It is recognize that applicant's prior art submission filed on (08/18/09) with respect to Honma et al (EP 1 091 258) having the same assignee, Nippon Zeon CO., LTD, as that in the instant application. The works are also done at Nippon Zeon Lab. Honma et al reference has the same or obviously about same teachings and/or suggestions as those in Oyama et al above and is cumulative.

V. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

VI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 7:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent

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Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoa V. Le/

Primary Examiner, Art Unit 1795

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